

### **Remarks**

Claims 4-16 and 26 are pending in this application and are rejected. Reconsideration of the claim rejections is requested in view of the following remarks.

#### **Claim Rejections – 35 U.S.C. 103**

The following obviousness rejections are asserted in the Office Action:

- (1) Claims 4-13, 14, 16 and 26 are rejected as being unpatentable over Monteiro in view of Srinivasan; and
- (2) Claim 15 is rejected as being unpatentable over Monteiro in view of Srinivasan and further in view of Kostreski.

Applicants respectfully assert that at the very least, the Office Action fails to present a *prima facie* case of obviousness against claim 13 based on the combined teachings of Monteiro in view of Srinivasan.

For example, the Examiner cites the disclosure of Monteiro in Col. 1, lines 11-15; Col. 4, lines 31-54, Col. 16, lines 29-40 as teaching *a scheduler operable to schedule time of insertion of a designated advertisement into selected broadcast multimedia program content, said scheduler being configured to receive and pre-cache advertisements from multiple sources to provide candidate advertisements for selection of said designated advertisement for insertion in said selected multimedia program content at a scheduled insertion time*, as claimed in claim 13. Applicants respectfully assert that the Examiner's reliance on Monteiro in this regard is misplaced.

At the very least, although Monteiro may arguably teach, on a general level, that real-time insertion of paid commercial advertising takes place at playback/control

workstations (see, Col. 4, lines 32-35 and FIG. 2), Monteiro does not specifically teach a *scheduler being configured to receive and pre-cache advertisements from multiple sources*. In fact, the Examiner essentially acknowledges that Monteiro does not specifically teach a *scheduler being configured to receive and pre-cache advertisements from multiple sources*, but contends (on page 9 of the Response to Arguments) that such teachings are “inherent” on the grounds that:

**one skilled in the art would know that radio and television commercial programming comes from multiple services and would therefore anticipate that the system of Monteiro is intended to have multiple sources of ‘paid commercial messages.’.**

However, Applicants respectfully assert that there is no basis for this finding as a matter of fact or law.

First of all, it is unclear what the Examiner means by *radio and television commercial programming coming from multiple services* and how the Examiner correlates, or otherwise characterizes, “multiple services” as being the same or remotely similar to the claim language of *advertisements from multiple sources*. In other words, there seems to be no logical connection, much less grammatical similarity, between “multiple services” and “multiple sources.” The Examiner should provide clarification in this regard.

Moreover, Examiner has not met the burden of proof to establish these teachings based on the doctrine of inherency. In order to rely on the doctrine of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In order for something to be “inherent” in a disclosure

it must be the necessary and only reasonable construction to be given to the disclosure, that is, the result claimed must inevitably occur. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic (In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Again, inherency cannot be established by possibility or probability; for a result to be deemed inherent, it must invariably exist or occur.

In the case at bar, the Examiner's finding that it would be inherent to have multiple advertising sources based on the teachings of Monteiro is merely conclusory and speculative, and the Examiner has offered no evidence or basis-in-fact to support the purported "inherent" teachings of Monteiro. In fact, the Examiner's finding of Inherency is easily undermined by the fact that it is also equally possible to have advertisements come from one source, and not multiple sources as claimed. For instance, FIG. 2 of Applicants specification teaches an *ad staging module* that outputs a plurality of ad feeds (54) to a multiplexer for selection (see page 11, lines 2-4). Monteiro does not specifically disclose this feature expressly, impliedly, or inherently, and the Examiner has not and cannot present a *prima facie* case of inherency in this regard.

Moreover, the Examiner cites the disclosure of Monteiro in Col. 7, lines 60-65 and Col. 5, line 65 - Col. 6, line 5 as teaching a multiplexer operable to provide multiple users with individualized composite program datastream *by performing in parallel for multiple users* (i) *insertion of a designated advertisement into a selected multimedia program content at a scheduled insertion time to form a composite program datastream, and (ii) coupling of said composite program datastream to a corresponding user of the*

*multiple users* , as claimed in claim 13. Applicants respectfully assert that the Examiner's reliance on Monteiro in this regard is misplaced.

Col. 5, line 65 ~ Col. 6, line 5 of Monteiro merely teaches that a primary server 20 can deliver a continuous sequence of packets to provide multicast packet delivery to a group, whereby such multicast can be performed by duplicating a unicast stream into more unicast streams to other media servers. Col. 7, lines 60-65 of Monteiro teaches nothing more than a general teaching that advertising may be incorporated into an audio stream within a network control center. From these teachings, the basis for the Examiner's finding that Monteiro teach a multiplexer that *operable to provide multiple users with individualized composite program datastream*, is wholly unclear. In fact, the Examiner should note that the term "multiplexer" or "multiplex" is not even included in the disclosure of Monteiro. Applicants find nothing in Monteiro that teaches or suggests a multiplexer, very much less a multiplexer that is configured to operate in the manner claimed in claim 13.

Accordingly, the Office Action at the very least fundamentally fails to set forth a *prima facie* case of obviousness of claim 13. Moreover, the teachings of Monteiro and Srinivasan are legally insufficient to establish a *prima facie* case of obviousness against claim 13.

Furthermore, since claims 4-12, 14-16, and 26 all depend directly or indirectly claim 13, such claims are patentable and non-obvious over the cited combination of references for at least the same reasons give for claim 13. Therefore, withdrawal of the obviousness rejections is requested.

Respectfully submitted,

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